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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/522,056  | 08/15/2005  | Peter Frost                 | C70512              | 3967             |
| 20462 7590 07/23/2009<br>SMITHKLINE BEECHAM CORPORATION<br>CORPORATE INTELLECTUAL PROPERTY-US, UW2220<br>P. O. BOX 1539<br>KING OF PRUSSIA, PA 19406-0939 |             |                             |                     |                  |
| EXAMINER<br>MAEWALL, SNIGDEHA   |             |                             |                     |                  |
| ART UNIT<br>1612  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>07/23/2009   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

US\_cipkop@gsk.com

### Office Action Summary

**Application No.**

10/522,056

**Applicant(s)**

FROST, PETER

**Examiner**

Snigdha Maewall

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
- Paper No(s)/Mail Date 01/20/05.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Summary**

1. Receipt of IDS filed on 01/20/05 is acknowledged.

Applicant's election with traverse of group I, claims 1-5, 8-10 and 12-18 in the reply filed on 04/02/09 is acknowledged. The traversal is on the ground(s) that there is unity of invention in the claims and there is no search burden. This is not found persuasive because the prior art by Henkel discloses aerosol dentifrice and hence breaks the unity among the three groups.

The requirement is still deemed proper and is therefore made FINAL.  
Applicant's election of Dimethylether and n-butane is also acknowledged.

Claims **6-7** and **11** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/02/09.

Claims **1-5, 8-10 and 12-18** are under prosecution.

### **Disclosure**

The use of the trademark Zeodent 163, Zeodent 623 and Zeodent 124 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 contains the trademark/trade name Zeodent 163. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe abrasive and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim **1-5, 8-10 and 12-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over WO0162211. ('211) (See Machine translation) in view of Stoltz (USP 5,824,289).

'211 discloses a propellant containing tooth cleaning agent, see title. The reference discloses tooth cleaning agents that contain polishing agents, humectants and tensides with celluloses that are filled in valve-operated dispenser filled with propellants, see abstract. The reference discloses stable dispersion which does not separate, see page 1, and paragraph 6. The amount of water is from 1-60 GEW by percent, see page 1, and paragraph 8. Various propulsion gas mixtures are provided on page 2, paragraph 1 isopentane, neopentane and isobutene etc.

Polishing agents, finery bodies or abrasives which remove the tartar are disclosed on page 2, last paragraph. The polishing agents are finely divided with grain sizes and the amounts are disclosed to be between 5-50 GEW %. Suitable metaphosphates, calcium carbonates, and calcium phosphates are and various polishing agents are disclosed on page 2, 2-3 paragraph. Various silicas and silicates,

alkali silicate and Zeodent are disclosed on page 2. wet retaining means such as glycerol, propylene glycol and sorbitol are disclosed on page 2, section 5. Various surfactants are disclosed on page 2, section 6. Example 1 discloses example 1

The reference does not specifically teach non-hydrocarbon propellant dimethylether propellant.

Stoltz teaches a foamable dental composition containing fluoride and aerosol propellant which provides stability to foam, see abstract and column 6, lines 61-67? The reference teaches well known propellant such as n-butane, propane and dimethylether with various psig vapor pressures. The reference also teaches chlorodifluoromethane propellants, se column 8, lines 45-50.

It would have been obvious to one of ordinary skill in the art at the time of instant invention to utilize the propellants such as n-butane and dimethylether in the primary reference in order to provide better dental foam stability motivated by the teachings of secondary reference.

Optimization of various amounts of various ingredients would have been within the purview of skilled artisan at the time of instant invention absent evidence to contrary.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/

Examiner, Art Unit 1612

/Gollamudi S Kishore/

Primary Examiner, Art Unit 1612